

### **REMARKS**

Claims in the case are 1-28, upon entry of this amendment. Claims 1 and 23 have been amended, no claims have been added, no claims have been cancelled herein.

Claims 1 and 23 have been amended herein to include closed-end transitional language with regard to the top layer coating composition.

Applicants wish to inform the Office of the following copending and commonly assigned patent application.

<b>U.S. Pat. Appl'n Serial No.</b>	<b>Filed</b>	<b>Attorney Docket No.</b>
10/673,903	09-29-2003	PO-7878 / LeA 35,782

Claims 1-5, 8-24, 27 and 28 stand rejected under 35 U.S.C. § 102(b) as being anticipated by WO 01/30922. This rejection is respectfully traversed with regard to the amendments herein and the following remarks.

The WO 01/30922 document will be referred to herein (as in the Office Action of 1 December 2005) with reference to United States Patent No. 6,855,396 B1 (**Mennig et al**), an English language equivalent thereof.

Mennig et al disclose a coated substrate that includes: a substrate (e.g., of plastic material); a hard basecoat layer prepared by a sol-gel process from hydrolyzable silane compounds; and a nanostructured topcoat that is prepared by applying a nanoscale composition comprising sol particles and/or particulate solids to the basecoat. See the abstract; column 3, line 17 through column 4, lines 21; column 8, lines 25-31; and column 11, lines 20-25 of Mennig et al.

The nanostructured topcoat of Mennig et al necessarily contains sol particles and/or particulate solids. Mennig et al do not disclose, teach or suggest a topcoat that is free of sol particles and/or particulate solids. The top layer of the multilayered article of Applicants' present claims is exclusive of sol particles and/or particulate solids.

In light of the amendments herein and the preceding remarks, Applicants' claims are deemed to be unanticipated by and patentable over Mennig et al. Reconsideration and withdrawal of the present rejection is respectfully requested.

Claims 6, 25 and 26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mennig et al. This rejection is respectfully traversed with regard to the amendments herein and the following remarks.

Mennig et al has been discussed previously herein, and discloses a coated substrate that includes: a substrate (e.g., of plastic material); a hard basecoat layer prepared by a sol-gel process from hydrolyzable silane compounds; and a nanostructured topcoat that is prepared by applying a nanoscale composition comprising sol particles and/or particulate solids to the basecoat. See the abstract; column 3, line 17 through column 4, lines 21; column 8, lines 25-31; and column 11, lines 20-25 of Mennig et al.

The nanostructured topcoat of Mennig et al necessarily contains sol particles and/or particulate solids. Mennig et al do not disclose, teach or suggest a topcoat that is free of sol particles and/or particulate solids. The top layer of the multilayered article of Applicants' present claims is exclusive of sol particles and/or particulate solids.

In light of the amendments herein and the preceding remarks, Applicants' claims are deemed to be unobvious and patentable over Mennig et al. Reconsideration and withdrawal of the present rejection is respectfully requested.

Claim 7 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Mennig et al in view of United States Patent No. 6,673,458 (**Mager et al**). This rejection is respectfully traversed with regard to the amendments herein and the following remarks.

Mennig et al has been discussed previously herein and discloses a coated substrate that includes: a substrate (e.g., of plastic material); a hard basecoat layer prepared by a sol-gel process from hydrolyzable silane compounds; and a nanostructured topcoat that is prepared by applying a nanoscale composition comprising sol particles and/or particulate solids to the basecoat. See the abstract; column 3, line 17 through column 4, lines 21; column 8, lines 25-31; and column 11, lines 20-25 of Mennig et al.

Mager et al disclose a process of producing sol-gel condensates that involves: (a) reaction an aqueous silica sol with a silicon alkoxide; and then (b) converting the condensate of step-(a) with a polyfunctional organoxilane (e.g., a cyclic carbosilane). See the abstract; column 2, lines 12-17; and column 2, line 66 through column 3, line 16 of Mager et al.

On page 10 of the Office Action of 1 December 2005 it is argued that the conversion step of Mager et al allows for or makes possible the addition of organic solvents to the sol-gel condensates. Applicants respectfully disagree, and submit that this position represents a mischaracterization of Mager et al.

Mager et al teach that rather than allowing for the addition of organic solvent, the conversion step principally **necessitates** the addition of organic solvent for purposes of preventing "excessively rapid gelling of the resulting sol-gel condensates." See column 4, lines 48-59 of Mager et al. As is known to the skilled artisan, extremely rapid curing of a coating composition imparts stresses into the coating that typically lead to failure thereof (e.g., delamination and/or adhesion failure) due to, for example, micro-cracks. As such a skilled artisan would not consider excessively rapid gelling of a coating composition as an "advantage" to be incorporated into Mennig et al.

In light of the preceding remarks, neither Mennig et al nor Mager et al provide the requisite disclosure that would motivate a skilled artisan to combine or otherwise modify their respective disclosures in an attempt to arrive at Applicants' presently claimed multilayered article. As the Court of Appeals for the Federal Circuit has stated, there are three possible sources for motivation to combine references in a manner that would render claims obvious. These are: (1) the nature of the problem to be solved; (2) the teaching of the prior art; and (3) the knowledge of persons of ordinary skill in the art. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1458 (Fed. Cir. 1998). The nature of the problem to be solved and the knowledge of persons of ordinary skill in the art are not present here and have not been relied upon in the rejection. As for the teaching of the prior art, the above discussion has established that neither of the patents relied upon in the rejection provide the requisite teaching, and certainly do not provide the motivation or suggestion to combine that is required by Court decisions.

The nanostructured topcoat of Mennig et al necessarily contains sol particles and/or particulate solids. Mennig et al do not disclose, teach or suggest a topcoat that is free of sol particles and/or particulate solids. As such, but for the impermissible use of hindsight reconstruction, a combination of Mennig et al and Mager et al would include a topcoat containing sol particles and/or particulate solids. The top layer of the multilayered article of Applicants' present claims is exclusive of sol particles and/or particulate solids.

The rejection appears to make impermissible use of hindsight reconstruction by picking, choosing and recombining various elements of the cited references in an attempt to arrive at Applicants' claimed invention. Modifying "prior art references without evidence of such a suggestion, teaching or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability -- the essence of hindsight." *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999).

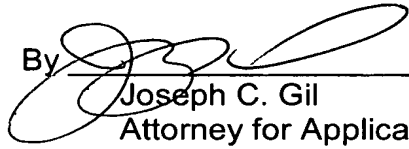
In light of the amendments herein and the preceding remarks, Applicants' claims are deemed to be unobvious and patentable over Mager et al in view of Mennig et al. Reconsideration and withdrawal of the present rejection is respectfully requested.

Claims 1-9 and 11-28 stand provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-31 of copending and commonly assigned United States Patent Application Serial No. 10/673,960 (Attorney Docket No. PO-7879) (hereinafter the '**960 application**'). This rejection is respectfully traversed with regard to the following remarks.

Included in the appendix herewith is a terminal disclaimer relative to the '960 application'. In light of the terminal disclaimer included herewith, the present rejection is deemed to have been overcome. Reconsideration and withdrawal of the present rejection is respectfully requested.

In light of the amendments herein and the preceding remarks, Applicants' presently pending claims are deemed to define an invention that is unanticipated, unobvious and hence, patentable. Reconsideration of the rejections and allowance of all of the presently pending claims is respectfully requested.

Respectfully submitted,

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# **APPENDIX**

Terminal Disclaimer Relative to  
United States Patent Application Serial No. 10/673,960  
(Attorney Docket No. PO-7879)